

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jeffrey A. Tilton et al.

Attorney Docket No.: 25363A

Serial No.: 10/789,143

Group Art Unit: 1794

Filed: February 27, 2004

Examiner: Piziali, Andrew T.

For: LAYERED POLYMER FIBER INSULATION AND
METHOD OF MAKING THEREOF

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant responds to the fourth Notification of Non-Compliant Appeal Brief ("Notification") mailed January 5, 2010, by providing a further Appeal Brief.

The Examiner previously requested that the Appeal Brief in the Status of the Claims Section not reference claims 6-8, 16-18 and 23, since their rejections were not expressly contested. Specifically, the Examiner stated that:

On page one of the appeal brief filed 7/23/2009 the appellant asserts that six grounds of rejection are being appealed and that nothing in the rules requires that every ground of rejection made by the examiner must be addressed on appeal. Based on said assertion, and based on the grounds of rejection to be reviewed on appeal section of said brief only referring to claims 1-5, 9-15, 19-22 and 24-27, only claims 1-5, 9-15, 19-22 and 24-27 are subject of this appeal. Therefore, claims 6-8, 16-18 and 23 are not subject to this appeal. Thus, the status of claims section incorrectly lists claims 1-27 as subject of this appeal, because only claims 1-5, 9-15, 19-22 and 24-27 are subject to this appeal according to appellant, and the claims appendix incorrectly includes claims 6-8, 16-18 and 23. Correction is required.

The Examiner thus concluded that "only claims 1-5, 9-15, 19-22 and 24-27 are subject of this appeal" based on his interpretation of the pertinent rule.

Appellant complied with the Examiner's request for correction to omit reference to claims 6-8, 16-18, and 23, but noted in the Appeal Brief accompanying letter that these claims are still on appeal. See Appeal Brief, page 1, "*Appeal is taken from the rejection of pending claims 1-27 made in the Office Action of April 21, 2008.*"

Having made the correction per the Examiner's specific request, the Notification now surprisingly states that claims 6-8, 16-18 and 23 have been withdrawn and thus are cancelled. Respectfully, Appellant did not withdraw the appeal with respect to these claims, as noted in the

Appeal Brief (which again states that “[a]ppeal is taken from the rejection of pending claims 1–27 made in the Office Action of April 21, 2008”). Rather, as stated in the accompanying correspondence, claims 6-8, 16-18 and 23 “depend from claims rejected for reasons subject to challenge, and thus are properly considered to be ‘on appeal.’” In making the prior correction, Appellant endeavored to comply with the Examiner’s formal requirements in order to have its Appeal Brief rightfully entered and considered.

Accordingly, all of claims 1-27 are being appealed. Appellant thus reverts to the language from the previous Appeal Brief referencing claims 1-27 as being “on appeal” based on the Examiner’s current interpretation of the requirement of the pertinent rule. If this is not deemed proper, then the Appellant respectfully requests that the Examiner telephone the undersigned to discuss the proper form of the Appeal Brief.

As for the additional objection with respect to claims 9, 10, 19, 20, and 24, the Examiner again cites no rule or authority that requires Appellant’s Brief to challenge each rejection made before the Board in order for a claim to be on appeal. Rather, as noted in the MPEP, the Appellant is entitled to appeal claims in dependent form that rely on the corresponding independent claims for patentability. See MPEP 1205.02 (“An appellant’s brief must be responsive to every ground of rejection stated by the examiner **that the appellant is presenting for review in the appeal.** For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y **and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1,** then one possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y”). In other words, not presenting arguments or headings referencing claims 2-5 in this hypothetical does not mean that these claims are not “on appeal.” This is precisely what the Appellant has done here. Accordingly, Appellant respectfully traverses the Examiner’s requirement.

As for claim 24, the Appellant does in fact address the rejection made in paragraph 17 on page 14 of the Appeal Brief. Specifically, the Examiner states in paragraph 17 that:

17. Claims 9, 10, 19, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,922,818 to Welch in view of anyone of USPN 5,958,186 to Holm, USPN 6,692,606 to Cederblad, or USPN 6,761,710 to D’Acchioli as applied to claims 1-5, 11-15, 21, 22 and 25-27 above, and further in view of USPN 5,616,408 to Oleszczuk or USPN 5,804,512 to Lickfield.

However, in making the statement of rejection for claim 24, the Examiner relies on Welchel, Oleszczuk and Lickfield, and makes no reference to Holm, Cederblad, D'Acchioli (which are relied upon in the rejection of claim 1, from which claim 24 depends):

Regarding claim 24, the first and second layers have different fiber compositions because one layer is composed of fibers with a small diameter while the other layer is composed of fibers with a larger diameter. In addition, Oleszczuk and Lickfield each disclose that at least one of the outer webs may be treated with a treatment agent to render any one of a number of desired properties to the fabric (column 12, lines 31-43 of Oleszczuk and column 4, lines 1-17 of Lickfield). It would have been obvious to one having ordinary skill in the art at the time the invention was made to treat at least one of the outer webs with a treatment agent to render any one of a number of desired properties to the fabric. Therefore, the first and second layers would have different fiber compositions because the outer layer would be composed of fibers comprising a treatment agent while the inner layer would be composed of fibers not comprising a treatment agent.

Appellant's argument has thus met the statement of rejection made for claim 24, and separately addressed the rejection of claim 1 over these references.

Please debit any fee due from Deposit Account 50-0568.

Respectfully submitted,
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